

Claims 17, 20, 26, 42, 57, 65, 71-73 and 79 have been amended. Claims 1-94 remain pending in this application.

Summary of the Rejections

Applicant traversed the prior rejections in the previous Office Action. In the present action, the Examiner set forth new grounds of prior art rejection. The Examiner maintained the double patenting rejections.

The Examiner rejected claims 1-3, 7, 8, 12, 17, 20-26, 29-32, 37-40, 42-47, 56, 57, 61-64, 74-78 and 80-85 based on non-statutory double patenting with respect to Applicant's U.S. Patent No. 5,802,280. The Examiner provisionally rejected claims 1, 2, 8, 9, 11, 13-17, 20-26, 31, 33-34, 37-39, 41-56, 61-65, 68-71 and 73-94 based on non-statutory double patenting with respect to Applicant's co-pending Application No. 08/871,221. The Examiner rejected claims 1, 3-10, 12, 16, 18-32, 35-40, 44, 46-69, 74-78, 80 and 82-84 based on non-statutory double patenting with respect to Applicant's U.S. Patent No. 5,764,892. The claims 1-8, 10, 17-40, 42-67, 71-76 and 81-94 were rejected under 35 U.S.C. 102(f) and 102(g) as being anticipated by U.S. Patent No. 5,802,280 to Cotichini. Claims 9, 11-16, 41, 68-70 and 77-80 were rejected under 35 U.S.C. §103(a) as being obvious over Cotichini in view of U.S. Patent No. 5,778,367 to Wesinger. These rejections are respectfully traversed.

Summary of the Invention

The present invention is directed to a novel method and apparatus for tracing an electronic device, such as a computer. According to the present invention, an Agent within the electronic device is configured to transmit identifying indicia for the electronic device (device

components thereof) to a host system automatically. In one aspect of the invention, a global network communication link (e.g., the Internet, cablevision network, telephone network, wireless radio network, microwave network, etc.) is provided to enable transmission between the electronic device and the host system. In another aspect of the present invention, the global network communication link is used for determining the location of the electronic device (e.g., by means of a traceroute routine and/or the location information within the identifying indicia).

The present application is a continuation-in-part of several parent and grandparent applications, which share certain overlapping disclosures but claim different inventive aspects. For example, parent U.S. Patent No. 5,802,280 (which was commonly assigned to the assignee of the present application) claims providing an identifying indicia of the electronic device, but does not more specifically claim determination of the location of the device based on tracing of the communication link as claimed in the present application.

Withdrawal of the Finality of the Office Action

The Examiner made the present Office Action final on the basis that Applicant's amendment in the prior response necessitated the new grounds of rejection presented in this Office Action. Applicant respectfully submits that the finality of the present action is premature.

In the prior response, Applicant amended independent claim 1, but not the other independent claims 37 and 57. Applicant traversed the earlier prior art rejections of independent claims 37 and 57 without any amendment in the prior response. In the present action, the Examiner applied new prior art against claims 37 and 57. The new rejections are therefore not

necessitated by any amendment. Accordingly, the present action should not be made final.

Withdrawal of the finality of the finality of the action is respectfully requested.

Traversal of Rejections

1. Non-Statutory Double Patenting Rejection

Applicant does not agree with the Examiner's basis for the non-statutory double patenting rejections with respect to U.S. Patent No. 5,802,280, U.S. Patent No. 5,764,892 and copending patent application serial no. 08/871,221. However, in the interest of forwarding this application to allowance and issuance, Applicant submits herewith a Terminal Disclaimer, without admission of the propriety of the rejection, or conceding to a presumption or estoppel on the merits of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ 2d 1392 (Fed. Cir. 1991). Applicant submits that the double patenting rejections have been traversed by the Terminal Disclaimer.

Applicant notes that the undersigned was appointed attorney representative in a Revocation of Prior Power of Attorney and Power of Attorney that was filed on May 11, 2000 along with the response to the earlier Office Action. However, it appears that the Power of Attorney had not been entered, as the present Office Action was mailed to the previous attorney or record. Applicant respectfully requests entry of the Power of Attorney filed earlier to make the undersigned of record. (A copy of the Power of Attorney is attached hereto.) Accordingly, the Terminal Disclaimer filed herewith executed by the undersigned attorney representative would be appropriate.

2. Prior Art Rejection Based on Cotichini

a. 102(f) and (g)

The present application claimed the priority of Cotichini. The present invention is a CIP of Applicant's application serial no. 08/871,221, which is in turn a CIP, in part, of the subject Cotichini patent (U.S. Patent No. 5,802,280). To clarify the relation, Applicant amended the specification to identify the Cotichini patent as one of the grand-parents of the present application. Such amendment is supported by the priority claims made in the parent applications.

Applicant respectfully submits that the inventors of the subject matter disclosed in Cotichini were the same as the inventors of the same subject matter disclosed and claimed in the present application. In fact, since the Examiner rejected the present application for double patenting over the Cotichini patent, on the basis that "the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter", then it follows that the inventors of the subject matter disclosed and claimed in the Cotichini patent (i.e., Christian Cotichini and Fraser Cain) must be the same as the inventors of the similar subject matter disclosed and claimed in the present application (Cotichini and Cain are named inventors in the present application). As such, Cotichini is not a proper reference that can be applied under § 102 (f) or (g). Accordingly, the 102 rejections based on Cotichini are respectfully traversed.

b. 103(a)

Applicant respectfully submits that U.S. Patent No. 5,802,280 to Cotichini and the present application have been commonly assigned to Absolute Software Corporation, the

assignee of record for the present application. The U.S. Patent No. 5,802,280 is a continuation of U.S. Patent No. 5,715,174, which assignment to Absolute Software Corporation was recorded at Reel/Frame 7474/0502; and the assignment of the present application was recorded at Reel/Frame 9455/0550. Further, Applicant respectfully submits that the subject matter of Cotichini and the presently claimed invention were, at the time the invention was made, owned by the assignee Absolute Software Corporation or subject to an obligation of assignment to assignee Absolute Software Corporation. Accordingly, pursuant to 35 U.S.C. 103(c), even assuming the subject matter of Cotichini qualifies as prior art only under subsection (f) and (g) of section 102, Cotichini shall not preclude patentability under section 103, either alone or in combination with Wesinger. The obviousness rejection is therefore traversed.

Claim Amendments

Applicant took the initiative to amend some of the claims to place them into better form and address certain potential section 112 issues. Applicant respectfully requests entry of the amendments. As noted above, the finality of the present action is premature. Upon withdrawal of the finality of the present action, the present amendments should be entered. Even if the finality of the present action is upheld, it is not inappropriate and is within the discretion of the Examiner to enter the present amendments, in view that the Examiner is familiar with the prior art and the issues, and the present amendments do not broaden the scope of the claims. No issue is raised by the present amendment which would require additional consideration by the Examiner. Also, no new search needs to be conducted.

Conclusion

In view of all the foregoing, Applicant submits that the claims pending in this application are patentable over the references of record and are in condition for allowance. Such action at an early date is earnestly solicited. In the interest of forwarding the case to allowance without unnecessary delays, the Examiner is invited to call the undersigned representative to discuss any outstanding issues that may not have been adequately addressed in this response.

Respectfully submitted,

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